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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : F. Randall Murray II
Serial No. : 10/675,121
Filed : September 30, 2003
For : APPARATUS, METHOD AND COMPUTER SYSTEM
FOR PROVIDING INSTANT MESSAGES RELATED TO
A CONFERENCE CALL
Group No. : 2444
Examiner : Joiya M. Cloud
Confirmation No. : 4965

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANT'S REPLY BRIEF

In response to the Examiner's Answer mailed April 12, 2011, this Reply Brief is submitted for the application identified above. Please charge any necessary fees to Nortel Networks Deposit Account No. 14-1315.

Appellant has reviewed the Examiner's Answer and response to Appellant's three main arguments that Dalal fails to disclose: (1) generating at the server one or more instant messages; (2) the one or more instant messages having Session Initiation Protocol (SIP) format; and (3) communicating the one or more SIP instant messages from the server to one or more of the plurality of participants.

First, the Final Office Action (dated March 3, 2010) and the Answer clearly and unequivocally assert that Dalal's service provider conference controller (SPCC) – as shown and described in Figure 1 and paragraph [0022] – meets the first recited element. That is, Dalal's SPCC is Appellant's recited "server." Because of this position, and to properly support the 102 rejection, the Examiner must show that this SPCC generates the instant message. However, the Examiner has failed to show (or even allege) that Dalal's SPCC performs this function. Instead, the Examiner argues that a different device – Dalal's VoIP-PSTN GATEWAY – generates a NOTIFY-HANG-UP message (which the Examiner interprets as the recited instant message). See, Examiner Answer, page 9. Because of this, the 102 rejection is fatally flawed at the outset.

To show this deficiency in the § 102 rejection, Appellant sets forth below in its entirety paragraph [0092] on which the Final Office Action and Answer rely as teaching "generating at the server one or more instant messages":

[0092] When the telephone user hangs up the phone, the VoIP-PSTN GATEWAY alerts the SM of the PSTN PROXY, which in turn releases resources used by the MIXER and ROUTER and then sends a NOTIFY-HANG-UP request to the SPMS. This request may include, but is not limited to, the CID of the conference and the telephone number. Upon receiving this request, the SPMS updates its conference database record and sends back a NOTIFY-HANG-UP-OK response to the SM of the

SPMS. In addition, the SPMS may relay the NOTIFY-HANG-UP request to the SPCC, which in turn, alerts the conference participants of the membership change as described earlier in this patent.

When the user hangs up, the VoIP-PSTN GATEWAY generates and sends a message to the PSTN PROXY, which in turn, generates and sends a NOTIFY-HANG-UP-OK request message to the SPMS, which in turn, may forward the NOTIFY request message generated by the PSTN PROXY to the SPCC (the server), which in turn, alerts the conference participants of the membership change “as described earlier in the patent.” Dalal, [0092]. Because the Examiner has equated the SPCC to the recited “server,” the Examiner must show that the SPCC “generates” an instant message. No such disclosure in Dalal exists. To the contrary, Dalal’s SPCC is described as being limited to only receiving and “forwarding” the NOTIFY request message generated by the SPMS (which was not identified as the “server” in the Final Office Action).

Second, nowhere in the cited paragraph [0092] is there any disclosure or description of how the SPCC “alerts” the conference participants of the hang-up event. Dalal merely states that the conference participants are “alerted,” with no further description in the cited paragraph as to how the participants are alerted, and by what means, or by what type of alert. Nowhere in cited paragraph [0092] is there any description or teaching that the “alert” – whatever that may be – is in a SIP format. While Dalal does refer to SIP INVITE request messages, these are in reference to setting up the conference call upon receipt of a CALL request. Dalal, paragraph 0089. The Answer argues that the devices PSTN PROXY and VOIP-PSTN support SIP (Answer, page 9), but neither of these devices are the recited “server.”

Finally, the Final Office Action and Answer argue that Dalal [0092] teaches “communicating one or more instant messages associated with the detected event from the server to one or more of the participants.” Final Office Action, page 3; Answer, page 9. More particularly, the Final Office Action points to a NOTIFY-HANG-UP request as equivalent to the recited instant message. Notwithstanding the Examiner’s sole reliance on paragraph [0092] of Dalal, Appellant points out that the description of a generic “alert” in paragraph [0092] does also refer to “as described earlier in this patent.” It is Appellant’s understanding that this reference is to Dalal’s description of a participant leaving the conference call (paragraphs [0068]–[0069]). As described in Dalal’s paragraph [0068], when a participant sends a LEAVE request, the “SPCC also notifies the current conference participants of the membership change by sending NOTIFY-CONF-MESSAGES . . . “ The cited portion fails to provide any disclosure or description of how the SPCC sends a NOTIFY-CONF-MESSAGE or of its message format. Further, nowhere in cited paragraph [0068] is there any description or teaching that the NOTIFY-CONF-MESSAGE is in a SIP format.

While the Answer has attempted to find each and every element as arranged as they are in Appellant’s claims, it is respectfully submitted that the 102 rejection is flawed and fails to meet the legal standards necessary to render the claims anticipated.

The Appellant has demonstrated that the present invention as claimed is clearly distinguishable over the prior art cited of record. Therefore, the Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Nortel Networks Deposit Account No. 14-1315.

Respectfully submitted,

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Date: _____

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